

### REMARKS

Claims 54, 55, 57, 60-63 and 66-70 are pending in the application. Claims 54 and 66 have been amended and are fully supported by the specification and drawings. No new matter is presented. Reconsideration is respectfully requested.

#### Claim Rejections 35 U.S.C. § 102(b)

Claims 54, 55, 57, 60-63 and 67-70 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Field (U.S. Patent No. 1,682,119). Further, claims 54, 55, 57, 60, 61 and 66-70 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bessler et al. (U.S. Patent No. 5,855,601). Applicant respectfully traverses. Independent claim 54 has been amended to recite a plurality of spring elements adapted to impart "a continuous" compressive force "of less than 3 mm Hg" to a portion of the heart during diastole and systole. Neither Field nor Bessler et al. teach spring elements adapted to impart a continuous compressive force of less than 3 mm Hg to a portion of the heart during diastole and systole. The language added to claim 54 by amendment herein is similar to the claim language recently allowed by the Examiner in U.S. Serial No. 10/714,189 in overcoming the art of record in that application. The present application and U.S. Serial No. 10/714,189 are related and both are continuations of U.S. Serial No. 09/052,116. It is respectfully urged that claim 54, as amended, and the claims that depend therefrom, are patentably distinguishable over Field and Bessler et al. for the same reasons that the Examiner allowed the claims in the '189 application. Accordingly, it is believed that the rejections under 35 U.S.C. § 102(b) have been overcome.

#### Claim Rejections Under 35 U.S.C. § 103

Claims 54, 55, 57, 60-63 and 66-70 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jayaraman (U.S. Patent No. 6,360,749) in view of Lau et al. (U.S. Patent No. 6,517,570). Applicant respectfully traverses. As set forth above, claims

having similar subject matter relating to a continuous compressive force of less than 3 mm Hg to a portion of the heart during diastole and systole was allowed specifically over Jayaraman and Lau et al. in U. S. Serial No. 10/714,189. Accordingly, Applicant believes independent claim 54, and the claims that depend therefrom, are patentably distinguishable over Jayaraman and Lau et al. for the same reasons as set forth in U.S. Serial No. 10/714,189.

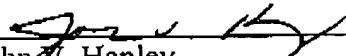
Claim Rejections Under 35 U.S.C. § 112

Claims 54, 55, 57, 60-63 and 66-70 have been rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for a device for applying a compressive force to the heart applied epicardially, does not reasonably provide enablement for a device for applying a compressive force to the heart applied endocardially. The claims as written clearly read on a medical device to treat the heart epicardially, and is fully supported by the specification and drawings. It is believed that there are numerous embodiments disclosed in the specification and drawings that support the claims reading on those embodiments for an epicardial application. That is all that is required under § 112. To the extent that the claims may be broad enough to cover a medical device that is implanted endocardially, which Applicant believes is the case, does not form a basis for rejection under § 112, first paragraph. Thus, it is respectfully urged that the rejection under § 112 be withdrawn since the claims, as amended, are fully supported by embodiments disclosed in the specification.

In conclusion, it is respectfully urged that claims 54, 55, 57, 60-63 and 55-70 are patentable over the art. If a telephone conference would facilitate prosecution of the application, the undersigned can be reached at (310) 824-5555.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By:   
John V. Hanley  
Registration No. 38,171

JVH:jeb

Howard Hughes Center  
6060 Center Drive, Tenth Floor  
Los Angeles, CA 90045  
Telephone: (310) 824-5555  
Facsimile: (310) 824-9696  
Customer No. 24201  
128736.1